



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,474	01/28/2004	Joseph Kirk Ollis	50037.207US01	3621
27488 7590 08/17/2011 MERCHANT & GOULD (MICROSOFT) P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
CHANKONG, DOHIM				
ART UNIT		PAPER NUMBER		
2452				
MAIL DATE		DELIVERY MODE		
08/17/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/767,474

**Applicant(s)**

OLLIS ET AL.

**Examiner**

DOHM CHANKONG

**Art Unit**

2452

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 11/11/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This non-final rejection is in response to Applicant's request for continued examination filed on 4/21/2010. Applicant amends claims 1, 10, 16 and cancels claim 6. Accordingly, Applicant presents claims 1-5 and 7-20 for further examination.

#### **I. CONTINUED EXAMINATION UNDER 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/21/2010 has been entered.

#### **II. INFORMATION DISCLOSURE STATEMENT**

The examiner has considered the information disclosure statement filed on 11/11/2010.

#### **III. RESPONSE TO ARGUMENTS**

Applicant amends the independent claims to recite subject matter relating to automatically adding an edited GAL contact as a personal contact to a user's personal contact list. As detailed in the next section, the feature of automatically adding the edited GAL contact is not supported in Applicant's specification.

The specification at page 9, lines 26-27 merely states that the GAL contact is added to the user's personal contact list upon selecting to edit the GAL contact. But this description does not

preclude the possibility of a user editing a contact and then being prompted to save the edited contact as a user's personal address. In other words, there is no description that an edited GAL contact is added as a personal contact without any user action.

Based on this interpretation of the claim language, *Huang* reads on the new limitation. Specifically, *Huang* discloses processing an address from a master address book (i.e., GAL contact) but where the address is not in a user's personal address book (i.e., as a personal contact) [Fig. 3e | column 9 «lines 63-67»]. Upon editing the contact [Fig. 3e «items 353»], the address is stored within the user's personal address book as a personal contact [Fig. 3e «item 355»].

For the foregoing reason, *Huang* discloses the limitation as claimed. See the next sections for further details and claim mapping.

#### IV. CLAIM REJECTIONS – 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**A. Claims 1, 10, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, there is no written support for the limitation reciting that the edited GAL contact is automatically added as a personal contact.

Figure 6 of Applicant's specification discloses adding the edited GAL contact as a personal contact but there is no explicit description that the adding step is done automatically. Similarly, the specification, at page 9, lines 26-27, merely states that the GAL contact is added to the user's personal contact list upon selecting to edit the GAL contact. While this sentence could imply that the adding step is done automatically, the specification does not require this interpretation. That is, there is no description stating that a user does not or cannot be involved in saving an edited GAL contact.

The specification only provides support for a limitation reciting that the GAL contact is added as a personal contact when edited. The specification leaves open the possibility that the adding step may be done either automatically or manually. Therefore, the limitation is rejected as failing to comply with the written description requirement.

## **V. CLAIM REJECTIONS - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- A. Claims 1, 3, 5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over *Schwartz et al*, U.S. Patent Publication NO. 2004/0135816 [*"Schwartz"*] in view of *Kobashikawa et al*, U.S. Patent NO. 7,539,699 [*"Kobashikawa"*], in further view of *Huang et al.*, U.S. Patent No. 5,966,714 [*"Huang"*].**

The applied reference *Schwartz* has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

All citations are to *Schwartz* unless otherwise noted.

#### **Claim 1**

*Schwartz* as modified by *Kobashikawa* and *Huang* discloses a method for populating a list of GAL contacts on a device, comprising:

automatically selecting global address list (GAL) contacts on a server for a user to include on the device in addition to user's personal contacts that are already stored on the device [0021: tracking "non-address book message targets" | 0052: step may be performed server side | *see also Kobashikawa*, Fig. 4: displays a web page that allows a user to select and add contacts at a server | column 7 «lines 35-52»];

on the server, removing any duplicates from the GAL contacts to ensure that the GAL contacts are unique from the user's personal contacts [0044: separate list of new recipients - therefore the addresses in the "non-address book" are unique | 0052: step may be performed server side];

preparing the GAL contacts [0044] to provide to the device including limiting a number of GAL contacts to be provided to the device [*Kobashikawa*, column 5 «lines 46-52»: limiting the addresses based on predefined criteria]; and

providing from the server the GAL contacts to the device [0044, 0052 | *see also Kobashikawa*, column 5 «line 63» to column 6 «line 6»: synchronizing server and client address books];

wherein the GAL contacts are incorporated with the user's personal contacts [0044] and wherein a display of the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view on the device [*Kobashikawa*, Fig. 2 «items 172, 174»: disclosing separating addresses into different folders but within the same contact view | column 6 «line 46» to column 7 «line 7»];

wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that

updates the provided GAL contacts [0044 – the non-address book is updated while the user's personal address book is maintained];

wherein a provided GAL contact is automatically added to the user's personal contacts when the user first edits the provided GAL contact on the device such that the provided GAL contact that was edited is one of the user's personal contacts during a next synchronization [see Response to Arguments above | *Huang*, Fig. 3e & column 9 «line 55» to column 10 «line 11»].

As noted above, *Schwartz* does not expressly disclose:

- (1) limiting the number of contacts to be provided to a client device;
- (2) a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view; or
- (3) automatically adding an edited GAL contact to the user's personal contacts.

However, these features were well known in the art at the time of Applicant's invention as evidenced by *Kobashikawa* and *Huang*.

1. *Kobashikawa* teaches limiting the number of contacts provided to the user based on predefined criteria.

Like *Schwartz*, *Kobashikawa* is directed to an invention for organizing contact addresses into an address book. *Kobashikawa* further discloses synchronizing address books between the server and the user device (i.e., providing addresses from the server to the user). Before performing this step, the number of addresses may be limited by predefined criteria [column 5 «lines 46-52»].

It would have been obvious to one of ordinary skill in the art to have modified *Schwartz* to include the ability to limit the number of contacts that are provided to the user device. Such a

modification would have improved *Schwartz*'s system because it has the advantage of only providing the most relevant addresses to the user [see *Kobashikawa*, column 5 «lines 47-49»].

2. *Kobashikawa* teaches providing a display that visually distinguishes between GAL and user's personal contacts.

*Kobashikawa* further discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders). In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user.

It would have been obvious to one of ordinary skill in the art to have modified *Schwartz* with this same feature to better organize the user's contact list. For example, *Schwartz* discloses three different lists: an MFU (most frequently used) list, a list of non-address book recipients, and a general contact list.

As modified by *Kobashikawa*, *Schwartz* would organize these different lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve *Schwartz* by better organizing the user's contacts.

3. *Huang* discloses adding an edited GAL contact to a user's personal contacts.

As noted in the foregoing claim mapping, *Huang* discloses providing a contact from a master address book (i.e., a provided GAL contact) and allowing a user to edit the contact. Upon editing, the contact may then be stored in a user's personal address book as a personal contact.

It would have been obvious to one of ordinary skill in the art to have modified *Schwartz's* system to include the functionality described above in *Huang*. As both *Schwartz* and *Huang* are directed to managing a user's personal contacts, such a modification to *Schwartz's* system is an example of using a known technique (*Huang's* step of adding edited contacts to a user's personal contact book) to improve similar systems (*Schwartz's* system for managing contacts) in the same way (*Schwartz's* system modified to allow users to edit contacts prior to storing them). See MPEP § 2143.

**Claim 3**

*Schwartz* discloses automatically selecting the global GAL contacts further comprises obtaining the GAL contacts from a user's emails including obtaining a primary addressee from each of a predetermined number of sent emails from the user [0044].

**Claim 5**

*Schwartz* discloses determining when one of the GAL contacts on the device is removed by the user and when one of the GAL contacts on the device is removed by the user preventing the removed GAL contact from being provided to the device during a subsequent synchronization after being automatically selected [0043: removing an entry from the list implies that the entry will not be added to the personal address book].

**Claim 7**

*Schwartz* discloses limiting the number of GAL contacts provided to device [0043].

**Claim 9**

*Schwartz* discloses the GAL contacts are obtained from a GAL store on a server [0052: discussing how all the features of the invention can be performed server side].

- B. Claims 10, 11, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang et al*, U.S. Patent No. 5,966,714 [*"Huang"*], in view of *Kobashikawa* and *Schwartz*.**

All citations are to *Huang* unless otherwise expressly noted.

**Claim 10**

*Huang* as modified by *Kobashikawa* and *Schwartz* discloses a system for populating a list of GAL contacts on a device, comprising:

a device including a communication connection, a data store, a display, and a processor that performs the following actions [Figure 1a «item 106» | Figure 1c «item 106» | column 5 «lines 36-37»], including:

connecting to a network using the communications connection to perform a synchronization [column 5 «lines 17-42»];

receiving an update list from the network containing information to update global address list (GAL) contacts that are unique from a user's personal contacts [column 2 «lines 27-31» : a change list | column 4 «lines 5-10» : generating a subset of a large address book] and are in addition to the user's personal contacts [Fig. 3e «steps 347-355»];

wherein the GAL contacts are synchronized differently from the user's personal contacts [*Schwartz*, 0044]; and

wherein the GAL contacts are visually distinguishable within a contact view from the user's personal contacts [*Kobashikawa*, Fig. 2 «items 172, 174»: disclosing separating addresses into different folders but within the same contact view | column 6 «line 46» to column 7 «line 7»];

updating the GAL contacts [column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»];

storing the updated GAL contacts in the data store [column 4 «lines 50-54» : memory within the client device]; and

displaying the GAL contacts on the display [Figure 1d]; and

when an edit is made to one of the GAL contacts while stored on the device automatically adding the edited GAL contact as a personal contact to the user's personal contacts on the device such that the edited GAL contact is one of the user's personal contacts during a next synchronization [see Response to arguments above | Fig. 3e «step 353, 354» & column 9 «line 55» to column 10 «line 11»];

a server including a communications connection, a data store, and a processor that performs the following actions [Figure 1c «items 127, 102»], including:

obtaining the GAL contacts for the user [column 6 «lines 8-12»];

preparing an update list based on the GAL contacts in the data store on the device and the obtained GAL contacts [column 7 «lines 26-32» | Figure 3e «item 350» :

preparing the information from the master address book | column 9 «lines 63-66»]; and

providing the GAL contacts to a device over the network [Figure 3e «item 355» | column 9 «lines 63-66»].

As indicated in the foregoing mapping, *Huang* does not expressly disclose:

- (1) wherein the GAL contacts are synchronized differently; or
- (2) the GAL contacts are visually distinguishable within a contact view from the user's personal contacts.

However, both of these features were well known in the art at the time of Applicant's invention as evidenced by *Schwartz* and *Kobashikawa*.

1. *Schwartz* discloses synchronizing the GAL contacts differently from the user's personal contacts.

Specifically, *Schwartz* discloses that the non-address book is updated while the user's personal address book is maintained [0044]. It would have been obvious to one of ordinary skill in the art to have modified *Huang*'s address book system to include *Schwartz*'s teaching. Such a modification is an example of applying a known technique (*Schwartz*'s synchronization feature) to a known system (*Huang*'s address book system) ready for improvement to yield predictable results (*Huang*'s system improved to allow for differentiated synchronization as taught in *Schwartz*).

2. *Kobashikawa* teaches visually distinguishing between GAL and user's personal contacts.

*Kobashikawa* discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders). In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user.

It would have been obvious to one of ordinary skill in the art to have modified *Huang* with this same feature to better organize the user's contact list. As modified by *Kobashikawa*, *Huang* would organize his lists into different folders (an MFU folder, a folder for contacts that are not currently in the address book, and a folder for general contacts) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also

display them within the same contact window would improve *Huang* by better organizing the user's contacts.

#### **Claim 11**

*Huang* discloses automatically selecting the GAL contacts further comprises obtaining the GAL contacts from the user's emails [column 5 «line 67» to column 6 «line 7»].

#### **Claim 15**

*Huang* discloses displaying the GAL contacts along with the user's personal contacts [Figure 1d].

**C. Claims 16, 19, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang* in view of *Kobashikawa*.**

#### **Claim 16**

*Huang* discloses a computer-readable storage medium including computer-executable instructions for populating a list of GAL contacts on a device, comprising:

beginning a synchronization session [column 4 «lines 5-18»];

automatically selecting global address list (GAL) contacts for a user that in addition to a user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails [column 4 «line 50» to column 5 «line 4» : receiving only a subset of the larger address book | column 6 «lines 1-14» | Figure 3e «item 347» : selecting contacts based on scanning email addresses from a user's Email folders and archives and determining whether the address is already in the user's personal address book (PAB)];

wherein the GAL contacts on the device are synchronized differently from the user's personal contacts on the device [Fig. 3e] such that when a GAL contact is deleted on the device,

a record is maintained indicating to remove the GAL contact from the automatically selected GAL contacts [column 5 «lines 30-32»: the address is deleted from the server's address book], before providing the GAL contacts to the device during a subsequent synchronization [column 6 «lines 52-60»: the queue serves as a record of the deleted address] ; and

wherein the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts [*Kobashikawa*, Fig. 2 «items 172, 174»: disclosing separating addresses into different folders but within the same contact view | column 6 «line 46» to column 7 «line 7»];

wherein a provided GAL contact is automatically added to the user's personal contacts when the user first edits the provided GAL contact on the device such that the provided GAL contact that was edited is one of the user's personal contacts during a subsequent synchronization [see Response to Arguments above | *Huang*, Fig. 3e & column 9 «line 55» to column 10 «line 11»]; and

providing the GAL contacts to a device [*Figure 3e «item 355» | column 9 «lines 63-66»*].

As noted above, *Huang* does not expressly disclose a display where the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Kobashikawa*. Like *Huang Kobashikawa* is directed to an invention for organizing contact addresses into an address book. *Kobashikawa* further discloses organizing different contacts into different folders in manner that allows the user to visually distinguish between contacts (because the contacts are placed and displayed in different folders).

In other words, because the contacts are in separate folders but within the same view, they are visually distinguishable to the user. It would have been obvious to one of ordinary skill in the art to have modified *Huang* with this same feature to better organize the user's contact list. For example, *Huang* discloses organizing messages into folders as well as retrieving only a subset of addresses from the personal contact list.

As modified by *Kobashikawa*, *Huang* would organize these different folders and the subset of contacts that are sent to the mobile device into different contact folders (such as a mobile phone contact folder) so that they can be displayed together but still visually distinguishable. Using folders to organize contacts but also display them within the same contact window would improve *Huang* by better organizing the user's contacts.

#### **Claim 19**

*Huang* discloses providing the GAL contacts to the device further comprising providing updates to the device in order to update a GAL contact store on the device [*column 4 «line 62» to column 5 «line 1» | column 6 «lines 60-64»*].

#### **Claim 20**

*Huang* discloses maintaining a user snapshot list outside of the device that is related to the GAL contacts for the user [*Figure 1c «item 128» | column 6 «lines 37-40»* : snapshot of the highest ranked addresses stored at the host device (outside of the user's mobile device)].

#### **D. Claims 12, 14, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang* and *Kobashikawa*, in further view of *Kraenzel et al*, U.S. Patent Publication No. 2005/0198144 [*"Kraenzel"*].**

As to claims 12, 14, and 17, *Huang* does disclose obtaining a primary addressee from sent emails from the user [*column 5 «line 67» to column 6 «line 7» | column 7 «lines 62-65» |*

column 9 «lines 44-67»], but does not expressly disclose scanning a predetermined number of sent emails from the user. However, the feature of specifying a number of sent emails to be retrieved and scanned was well known in the art at the time of Applicant's invention as evinced by *Kraenzel*.

*Kraenzel* is directed towards a system for managing message addressed by extracting the information from emails [*abstract*]. *Kraenzel* discloses that a user can specify the number of emails to search to extract the addressee information [*Figure 3 : specifying number of messages if more than a certain number* | 0060-0062]. It would have been obvious to one of ordinary skill in the art to have adapted *Huang's* system to include *Kraenzel's* user selectable filters. One would have been motivated to adapt *Huang* because the filters increase the amount of control that a user has over the number of messages to be scanned.

**E. Claims 13 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Huang* and *Kobashikawa*, in further view of *Lake*, U.S. Patent No. 7.200.638.**

As to claims 13, and 18, *Huang* does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evinced by *Lake*. *Lake* is directed towards a system for automatically populating a contact list [*abstract*]. *Lake* teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3* | column 2 «lines 6-11»]. It would have been obvious to one of ordinary skill in the art to have adapted *Huang's* system to include *Lake's* automatic population functionality. *Lake* teaches that such a feature more efficiently manages a user's contact list [column 1 «lines 51-62»].

**F. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz, Kobashikawa, and Huang*, in further view of *Kraenzel*.**

As to claim 2, *Schwartz* discloses obtaining the GAL contacts from emails [abstract] but does not disclose obtaining the GAL contacts from other forms of communication. However, extracting contact information from a variety of communications was a well known feature in the art at the time of Applicant's invention as evidenced by *Kraenzel*. *Kraenzel* teaches obtaining contacts from phone calls, SMS or IM messages, and user meetings [0030, 0031: discussing the application of his extraction feature in a variety of products including instant messaging, discussion forums or other multi-part communication systems]. It would have been obvious to one of ordinary skill in the art that the forms of communication being claimed in claim 2 are contemplated by *Kraenzel* as multi-part communication systems. It would have been further obvious to one of ordinary skill in the art to have modified *Schwartz*'s system with the ability to obtain contacts from a wider variety of communications as taught by *Kraenzel*. Such a modification substantially increases the number of contacts that may be included in the contact list.

**G. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz, Kobashikawa, and Huang*, in further view of *Lake*.**

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

#### **Claim 4**

As to claim 4, *Schwartz* does not expressly disclose obtaining the GAL contacts from meeting requests. However, the feature of extracting contact information from meeting requests was well known in the art at the time of Applicant's invention as evidenced by *Lake*. *Lake* is directed towards a system for automatically populating a contact list [*abstract*]. *Lake* teaches that one of the ways to accomplish this task is to extract the contacts from meeting information found in a user's calendar [*Figure 3 | column 2 «lines 6-11»*]. It would have been obvious to one of ordinary skill in the art to have adapted *Schwartz*'s system to include *Lake*'s automatic population functionality. *Lake* teaches that such a feature more efficiently manages a user's contact list [*column 1 «lines 51-62»*].

- H. Claim 8 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Schwartz*, *Kobashikawa*, and *Huang*, in further view of *Calder et al*, U.S. Patent Publication No. 20010034244 [*"Calder"*].**

*Schwartz* does disclose maintaining a snapshot list that excludes the user's personal contacts [0044] but does not disclose maintaining a snapshot list outside of the device. However, such a feature was well known in the art at the time of Applicant's invention as evidenced by *Calder*. *Calder* discloses maintaining several snapshot lists outside of the user's device [Fig. 4 | 0054; disclosing multiple fone lists that may be individually downloaded to the handset]. *Calder* discloses the benefit of this feature allows a user to maintain a variety of contact lists for different purposes and downloading them as needed [0055: a list for contacts from a first country and a list for contacts from a second country]. Therefore, it would have been obvious to one of ordinary skill in the art to have modified *Schwartz* to include the snapshot list feature as taught by *Calder*.

## VI. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/  
Primary Examiner, Art Unit 2452